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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,986	02/07/2002	Tetsuya Niitsuma	02060/LH	1594

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EXAMINER

AYELE, MARIO

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/071,986	<b>Applicant(s)</b> NIITSUMA, TETSUYA	
	<b>Examiner</b> Mario Ayele	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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**DETAILED ACTION*****Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) is required in this application because several features claimed are not displayed. The drawings do not display: first image processing means, read data transmitting means, read data transmitting means, second image processing means, written data transmitting means, image outputting means, a function selecting means, job registering means, priority order determining means, second control means, second storage means, job registering means, priority order determining means, remaining capacity detecting means, first necessary storage capacity estimating means, second necessary storage capacity estimating means. The applicant only discloses one control means and one storage means. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

**Claim 1** recites the limitation "a written data transmitting means for transmitting said image data" and "an image outputting means for selecting either one of said image

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data, processed by said first image processing means, or said image data, transmitted by said written data transmitting means, so as to output said image data as an image" It is unclear which "image data" is being claimed: the image data after image is read or image data after "first processing means". There is insufficient antecedent basis for this limitation in the claim.

Also in **claim 1**, the paragraph that begins with "a first control means", specifically "controlling said written data transmitting means to transmit said image data by transmitting said image data to said second image processing means with said read data transmitting means", it is unclear which means transmits to the second processor.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatake (US 6,065,036) in view of Atobe et al. (US 6,281,979)

Regarding **claim 1**, Hisatake discloses an image reading means for reading an image on a document and for converting image into image data (column 4, lines 42-44; figure 1, element 3), a first control means, in accordance with desired

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image processing function selected by function selecting means, for controlling first image processing means to process image data, or controlling written data transmitting means to transmit image data by transmitting image data to second image processing means with read data transmitting means and by processing image data with second image processing means (column 4, lines 53-56), a job registering means for registering a plurality of jobs in relation with an image forming process, a priority order determining means for determining a priority order for output of plurality of jobs (column 4, lines 39-42), a second control means for determining an outputting order of said image data, corresponding to each of plurality of jobs, to be outputted from image outputting means in accordance with priority order, and for controlling image outputting means so as to output image data, corresponding to one of plurality of jobs whose priority order is the highest among plurality of jobs which are able to be outputted immediately, when immediate output of image data, corresponding to other one of said plurality of jobs, is impossible because of a process by second image processing means (column 2, lines 26-34).

However, Hisatake fails to expressly disclose a first image processing means for processing image data, a read data transmitting means for transmitting image data, a second image processing means for processing image data a written data transmitting means for transmitting image data an image outputting means for selecting either one of image data, processed by first image processing means, or image data, transmitted by said image data as an image, a function selecting means with for selecting a desired image processing function.

Atobe et al. discloses a first image processing means for processing image data, a read data transmitting means for transmitting image data (figure 3, element 13; column 5, lines 33-35), a second image processing means for processing image data a written data transmitting means for transmitting image data (figure 3, element 14; column 5, lines 36-37), an image outputting means for selecting either one of image data, processed by first image processing means, or image data, transmitted by said image data as an image, a function selecting means with for selecting a desired image processing function (column 4, lines 26-29)

Hisatake and Atobe et al. are combinable because they are from the same field endeavor, both being image processing apparatuses. At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the inventions of Hisatake and Atobe et al. because adding a processor selecting function allows different types of data to be processed.

**Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatake in view of Atobe as applied to claim 1 above, and further in view of Yoshida.

Regarding **claim 2**, the rationale provided in the rejection of claim 1 is incorporated herein. Hisatake does not teach a display means for displaying that outputting order has been changed due to process by second image processing means. This was known and taught by Yoshida et al. discloses comprising a display means for

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displaying that outputting order has been changed due to process by second image processing means (Figure 10). It would have been obvious to a person of ordinary skill in the art to combine the inventions of Hisatake and Yoshida et al. so that users can see the priority in the printing of jobs.

### ***Allowable Subject Matter***

Claim 3 is allowed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mario Ayele whose telephone number is 571-272-0624. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Mario Ayele  
Examiner  
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A handwritten signature in black ink, appearing to read "Mark Zimmerman", with a long horizontal flourish extending to the right.

MARK ZIMMERMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600